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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,720	10/29/2003	Stanley N. Cohen	5398-027-27 CONT	3761

22506 7590 04/19/2007  
JAGTIANI + GUTTAG  
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FAIRFAX, VA 22030

EXAMINER
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YU, MISOOK

ART UNIT	PAPER NUMBER
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1642

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/697,720

Applicant(s)

COHEN ET AL.

Examiner

MISOOK YU, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-33 is/are pending in the application.
- 4a) Of the above claim(s) 31-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- II. Claims 31 and 32, drawn to a complex comprising protein and antibody, classified in class 530, subclass 387.1.
- III. Claim 33, drawn to antibody, classified in class 530, subclass 387.1.

The inventions II, and III are distinct from the invention (polypeptide) already examined on merits. In the instant case, in this instance the already examined polypeptide is a single chain molecule, whereas the antibody in group II and III including IgG which comprises 2 heavy and 2 light chains containing constant and variable regions, and including framework regions which act as a scaffold for the 6 complementarity determining regions (CDRs) that function to bind an epitope. Thus the already examined polypeptide and the antibody are structurally distinct molecules; any relationship between a polypeptide and an antibody is dependent upon the correlation between the scope of the polypeptides that the antibody binds and the scope of the antibodies that would be generated upon immunization with the polypeptide.

In this case, the polypeptide is a large molecule, which contains potentially hundreds of regions to which an antibody may bind, whereas the antibody is defined in terms of its binding specificity to a small structure within the polypeptide.

Furthermore, searching the inventions of group II and group III would impose a serious search burden. The inventions have a separate status in the art as shown by their different classifications. A polypeptide and an antibody, which binds to the polypeptide, require different searches. An amino acid sequence search of the full-

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length protein is necessary for a determination of novelty and unobviousness of the protein. However, such a search is not required to identify the antibodies of group III. Furthermore, antibodies which bind to an epitope of a polypeptide may be known even if a polypeptide is novel. Group II and Group III above are different invention because Group II have two different active ingredients, while group III have a single active ingredients.

Claims 29-33 are pending. Claims 31-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b). Claims 29 and 30 are under consideration in this Office action. All the rejection and objection made in the previous Office action are moot because the rejected claims are cancelled.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 29 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection has two parts.

First, the new limitation "amino acids 11-390 of SEQ ID NO: 4" does not have support in the specification as originally filed.

Second, claims 29-30 are drawn to genus of polypeptides.

The applicable standard for the written description requirement can be found: MPEP 2163; University of California v. Eli Lilly, 43 USPQ2d 1398 at 1407; PTO Written Description Guidelines; Enzo Biochem Inc. v. Gen-Prove Inc., 63 USPQ2d 1609; Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111; and University of Rochester v. G.D. Searle & Co., 69 USPQ2d 1886 (CA FC 2004).

To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present in the claim is a partial structure. There is not even identification of any particular function associated with the genus of polypeptides comprising the specifically recited portion. The present claims 29 and 30 encompass protein s encoded full-length genes and cDNAs (such as differently spliced isoforms of said full-length gene) that are not further described. There is substantial variability among the species of DNA s encompassed within the scope of the claims because "amino acids residue 11-390 of SEQ ID NO:4" is only a fragment of the full-length protein. A description of a genus of proteins may be achieved by means of a recitation of a representative number of proteins, defined by amino acids sequences, falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. Accordingly, in the absence of sufficient recitation of distinguishing identifying

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characteristics, the specification does not provide adequate written description of the claimed genus.

***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) and 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/804,690, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. SEQ ID NO: 4 disclosed in 09/804,690 has 380 amino acids, while the instant SEQ ID NO: 4 has 390 amino acids (note previously Exhibit A). Accordingly, claims 29 and 30 are not entitled to the benefit of the prior application. Therefore the effective filing date of the instant claims 29 and 30 is 10/29/2003. SEQ ID NO: 4 as disclosed in Application No. 09/804,690 (i.e. polypeptide comprising 380 amino acid residues) will be given the earlier filing date.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by GenBank Accession No U8213 (04-Jun-1998).

Claims 29 and 30 are drawn to SEQ ID NO: 4 protein.

GenBank Accession No U8213 teaches the instant SEQ ID NO: 4 protein.

Claims 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 5,892,016 (Brie et al., 06-apr-1999).

Claims 29 and 30 are drawn to SEQ ID NO: 4 protein and pharmaceutical comprising the protein in conjunction with a suitable carrier.

Brie et al., teach an isolated protein identical to the instant SEQ ID NO: 4 (note previously provided Exhibit B).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 30 is rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

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Claim 30, as written, do not sufficiently distinguish the protein as it exists naturally because the claim does not particularly point out any non-naturally occurring differences between the claimed product and the naturally occurring product. This rejection is made because the limitation "free of other proteins and polypeptides" is interpreted as saying the claimed polypeptide is not complexed with other proteins and polypeptides. The specification or any other art of record teaches that the claimed polypeptide is not free of other proteins and polypeptides in vivo. In other words, absence showing the polypeptide being not free of the other proteins and polypeptides in vivo, the scope of claim 30 includes the polypeptide that exists in vivo free of other proteins and polypeptides. Thus, in the absence of the hand of man, the naturally occurring product is considered non-statutory subject matter. See *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980). The claim should be amended to indicate the hand of the inventor, e.g., by insertion of "Isolated" or "Purified" as taught by page [insert page number] of specification. See MPEP 2105.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not



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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on 571-272-0898. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MISOOK YU, Ph.D.

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Primary Examiner  
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MISOOK YU  
PRIMARY EXAMINER